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EXAMINER

ALLEN, WILLIAM J

ART UNIT

PAPER NUMBER

3625

NOTIFICATION DATE

DELIVERY MODE

12/21/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Office Action Summary	Application No. 09/707,273	Applicant(s) HUNTER ET AL.	
	Examiner WILLIAM ALLEN	Art Unit 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 40-41, 43-53, 55-65, 67, 71, 73-78 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Prosecution History Summary

Claims 73-78 have been added.

Claims 40-41, 43-53, 55-65, 67, 71, 73-78 are pending and rejected.

Allowable Subject Matter

Claims 45-46 and related claims 57-58 and 74-75 are noted as being dependent upon a rejected base claim, but would be allowable if:

(1) rewritten in independent form including all of the limitations of the base claim and any intervening claims, **and**

(2) any rejections under 35 USC 101, 112, etc. are overcome.

Response to Arguments

With respect to the rejection of independent claim 40 and its dependents under 35 USC 101, Applicant's arguments have been fully considered and are persuasive. Moreover, for at least the reasons following the rejections are hereby withdrawn. Applicant's specification, page 15 (lines 14-20) and page 25 (lines 7-17) describe where a central controller system and billing computers are utilized in the billing/charging process. Moreover, with respect to the claim, Applicant has recited "automatically" charging a user. In view of Applicant's specification, it would not be a proper interpretation to construe "automatically charging" as not connected to some type of computing system such as the central controller, billing computer, or the like. Moreover, it would not be proper to read "automatically" as an operator manually billing the user. As such, because the automatic charging is taken to be a significant step, and further because the automatic charging is effected by a machine or apparatus, claim 40 (and

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dependents) are hereby considered statutory subject matter and the rejection under 35 USC 101 has been withdrawn.

With respect to the rejection of claim 52 and its dependents under 35 USC 101, Applicant's arguments/amendments have been fully considered and are persuasive. The rejection is hereby withdrawn.

With respect to the rejection of claim 64 and its dependents under 35 USC 101, Applicant's arguments/amendments have been fully considered and are persuasive. The rejection is hereby withdrawn.

With respect to the rejection of claims 40-41, 43-53, 55-65, 67, and 71 under 25 USC 112, First Paragraph, Applicant's arguments have been fully considered but they are not persuasive. More specifically, on the bottom of page 14-top of page 15, Applicant reasons that if billing of a customer account happens in response to the customer permanently recording music, then some indication of permanent recording must be received. At most, the reception of an indication is implied, however, the indication is not described to be in conjunction with the permanent storage. The cited portion by applicant merely recites that a user may elect to permanently store a music selection, "with automatic billing that appears on the customer's consolidated monthly statement". Again, the "automatic billing" is not necessarily linked to the permanent storage in the noted passage. Even assuming that there is enough of an implication to support broadly "receiving an indication", such rationale does not compensate for a lack of support for the indication indicating that "at least a portion of said music selection has been recorded from said intermediate storage medium to a permanent storage medium".

In this regard, Applicant cites page 28 lines 15-18 as support (see second paragraph, p. 15 of Applicant's Remarks). Lines 15-18 of p. 28 read "When the user station is provided with a

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storage module 130 having a substantial data storage capacity, *it is possible for many recordings to be immediately available to the customer for permanent recording*". Though such recitations support the possibility of a user recording from intermediate storage to permanent storage, they do not amount to the express support of *receiving an indication* that at least a portion of said music selection has been recorded from said intermediate storage medium to a permanent storage medium. In fact, nowhere in Applicant's specification is there implied or explicit support for such an indication.

With respect to the rejection of claims 64-65, 67, and 71 under 35 USC 112, Second Paragraph, Applicant's amendments/remarks suffice to overcome the noted rejections; however, new grounds of rejection under 35 USC 112, First and Second Paragraph have been raised.

With respect to Applicant's arguments that the combination of Wiser and Hamada fails to teach certain features, these arguments have been considered but are not persuasive.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). On page 17, Applicant alleges that both Wiser and Hamada, individually, fail to teach where the charging *is in response to an indication that at least a portion of the media has been stored in a permanent storage medium at the consumer site*. The Examiner disagrees with these allegations for at least the following:

Wiser teaches *receiving an indication that at least a portion of the music selection has been recorded in said intermediate storage medium* and that a subsequent request to purchase

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the media selection, said purchase request including a request to store the music selection in a permanent storage medium at said consumer site [see at least: col. 12 lines 12-19, col. 19 lines 18-22, col. 20 lines 45-49 and 56-57, col. 21 lines 41-46, col. 22 lines 56-58, col. 29 lines 4-12, col. 31 lines 24-37]. Wiser further teaches *responsive to said indication, automatically charging the consumer for the music selection* [see at least: col. 19 lines 28-43, col. 20 lines 56-57, col. 21 lines 1-4 and 26-35]. In other words, Wiser effectively teaches storing a selection in intermediate storage, requesting permanent storage of the selection, and subsequently charging the user for the permanent storage where the charging is done prior to the storage of the media in permanent storage media.

In the same field of endeavor, Hamada teaches *is in response to an indication that at least a portion of the media has been stored in a permanent storage medium at the consumer site* [see at least: col. 6 lines 36-52, col. 7 lines 55-67, Fig. 14 #s206-208]. More specifically, Hamada states that storage device 13 (analogous to *intermediate* storage) is used to store downloaded audio data (analogous to *music selections*). Hamada functions to allow a user to purchase and permanently store the music selection, and charges the user after the selection has been downloaded (i.e. permanently stored).

Additionally, Hamada teaches where the storage device 13 not only functions as an intermediate storage for the music selections, but further facilitates permanent recording as it functions as a mini disk recorder-player, a DAT (digital audio tape) recorder-player, a DVD (digital video disk or digital versatile disk) recorder-player, etc., may be used. Likewise, Hamada teaches where the audio files may be recorded on CD-R (recordable compact disks). As Applicant has contested his specification is supportive of recording from intermediate storage to permanent storage, the Examiner asserts that the same threshold must be used to determine whether Hamada teaches such aspects. Applicant's specification the set top box acting as a CD

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burner [p. 28 lines 7-12] and further, where the user station is provided with a storage module that allows many music selections to be available for permanent recording [p. 28 lines 15-18]. Moreover, page 26 lines 11-17 states "*When the download is completed, the customer user interface flashes a cue such as "YOU'VE GOT TUNES", following which the customer may permanently record the music, with automatic billing that appears on the customer's consolidated monthly statement*".

The functionality described and asserted by Applicant to support that a selection is transferred from intermediate storage to permanent storage is precisely what Hamada is implying in the disclosure. In other words, Hamada teaches:

- The storage of music selections in intermediate storage for preview
- The immediate availability of those recordings for purchase (i.e. permanent storage)
- The storage device functioning as a CD, DVD, or similar-type recorder for recording purchased copies (i.e. for permanently storing the copies)
- The billing/charging of the user only after the purchase is downloaded (i.e. permanently stored)

Again, if Applicant's allegation is that Applicant's specification is clearly supportive by the suggestion that a device is capable of burning or otherwise storing permanent copies of music selections intermediately stored, then it is unclear how Hamada is deficient when Hamada provides an analogous description with equivalent implications.

In view of the above, the Examiner asserts that the combination of Wiser in view of Hamada teaches the invention as claimed. This action is hereby made Final.

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Claim Rejections - 35 USC § 112 – First Paragraph

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 40-41, 43-53, 55-65, 67, 71, and 73-78 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claims 40-41 and 43-51, claim 40 recites various features not supported by the original disclosure. For example, newly amended claim 40 recites “receiving an indication”; however, there is no express support for the transmission or reception of an indication. At most, the reception of an indication is implied but never described by the specification.

To the same accord, even assuming that there is enough of an implication to support receiving an indication, Applicant’s specification fails to describe where the indication indicates that “at least a portion of said music selection has been recorded *from said intermediate storage medium to a permanent storage medium*”. For example, the following are representative quotations appearing in Applicant’s specification:

- Page 8, lines 18-21 recite where “the customer may preview the stored music for free and thereafter decide whether to purchase a permanent copy. If the purchase decision is made, a full quality CD is recorded via a CD writer that may be part of the user station”.
- Page 26, lines 11-17 recite “on the designated “music channel” until the requested recording is downloaded to intermediate storage in storage module 130. When the

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download is completed, the customer user interface flashes a cue such as "YOU'VE GOT TUNES", following which the customer may permanently record the music, with automatic billing that appears on the customer's consolidated monthly statement. This hourly transmission of top requested recordings

As can be seen, although the specification is supportive of storing a music selection in intermediate storage and sometime thereafter permanently storing the music selection, nowhere in Applicant's specification is there support for recording *from* the intermediate storage *to* permanent storage. Furthermore, as there is no support for recording from intermediate storage to permanent storage, there can be no support for receiving an indication that such has taken place.

For examination purposes, the step will be interpreted as "receiving an indication that at least a portion of the music selection has been stored in intermediate storage and subsequently stored in permanent storage" (i.e. not necessarily transferred from intermediate to permanent storage).

Additionally, claims 52-53, 55-63, 64-65, 67, and 71 recite similar features as noted above and are thereby rejected for at least the above rationale.

For at least the reasons above, the newly amended claims lack written correspondence in the specification and are thereby properly rejected under 35 USC 112, First Paragraph.

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Specifically regarding claim 64 and claims 65, 67, 71, 73-75, and 78, Claim element “means for receiving an indication that at least a portion...” is a means (or step) plus function limitation that invokes 35 U.S.C. 112, sixth paragraph. However, the written description fails to disclose the corresponding structure, material, or acts for the claimed function. Moreover, as previously claimed, the newly recited means for limitations were recited as “mechanisms”, the mechanisms drawn to program code/software. If such program code/software is what Applicant considers the structure or material to perform the noted functionality, then the Examiner hereby asserts that Applicant has failed to set forth any algorithm, coding, or the like necessary to perform the necessary functionality. Again, the newly recited “means for” are not supported under such a scenario, and thus are properly rejected as failing to claim subject matter corresponding to the original disclosure.

Similar issues exist for dependent claims 65, 67, 71, 73-75, and 78. In view of the above, Applicant is required to:

- (a) Amend the claim so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or
- (b) Amend the written description of the specification such that it expressly recites what structure, material, or acts perform the claimed function without introducing any new matter (35 U.S.C. 132(a)).

If applicant is of the opinion that the written description of the specification already implicitly or inherently discloses the corresponding structure, material, or acts so that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function, applicant is required to clarify the record by either:

- (a) Amending the written description of the specification such that it expressly recites the corresponding structure, material, or acts for performing the claimed function and clearly links or

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associates the structure, material, or acts to the claimed function, without introducing any new matter (35 U.S.C. 132(a)); or

(b) Stating on the record what the corresponding structure, material, or acts, which are implicitly or inherently set forth in the written description of the specification, perform the claimed function. For more information, see 37 CFR 1.75(d) and MPEP §§ 608.01(o) and 2181.

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Claim Rejections - 35 USC § 112 – Second Paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 64-65, 67, 71, 73-75, and 78 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim elements “means for receiving an indication that at least a portion...” and “means for automatically charging...” are a means (or step) plus function limitations that invokes 35 U.S.C. 112, sixth paragraph. However, the written description fails to clearly link or associate the disclosed structure, material, or acts to the claimed function such that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function. Specifically speaking, there is no express recitation in Applicant's specification of receiving an indication (this step is at best only implied). Moreover, there is no clear indication, explicitly stated or implied, of what structure may be tied to said reception.

Furthermore, in respect to a means for automatically charging, though there is support for structure tied to the functionality, it is unclear exactly what is to be considered the structure responsible for performing the noted functionality of charging. More specifically, multiple devices or means are described in relation to the functionality of charging. For example, Applicant describes a control system, a billing computer, and a billing module designed for charging/billing a customer. As there is no clear disclosure that links a particular means to the functionality, the Examiner hereby asserts that it is unclear as to what structure and what equivalents in the prior art may be applicable.

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Moreover, as previously claimed, the newly recited means for limitations were recited as “mechanisms”, the mechanisms drawn to program code/software. If such program code/software is what Applicant considers the structure or material to perform the noted functionality, then the Examiner hereby asserts that Applicant has failed to set forth any algorithm, coding, or the like necessary to perform the necessary functionality.

Similar issues exist for dependent claims 65, 67, 71, 73-75, and 78. In view of the above, Applicant is required to:

(a) Amend the claim so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or

(b) Amend the written description of the specification such that it clearly links or associates the corresponding structure, material, or acts to the claimed function without introducing any new matter (35 U.S.C. 132(a)); or

(c) State on the record where the corresponding structure, material, or acts are set forth in the written description of the specification that perform the claimed function. For more information, see 37 CFR 1.75(d) and MPEP §§ 608.01(o) and 2181.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 40-41, 48-51, 52-53, 60-63, 64-65, 67, and 71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiser (US 7263497) in view of Hamada (US 6792007).

Regarding claim 40, Wiser teaches a method comprising:

receiving a consumer request for a music selection [see at least: col. 12 lines 12-19, col. 17 lines 21-33, Fig. 7 #702-704, Fig. 8, Fig. 14];

responsive to said consumer request, transmitting the music selection to an intermediate storage medium at a consumer site [see at least: col. 12 lines 12-19, col. 13 lines 57-63, col. 18 lines 6-19 and 39-51, col. 18 line 63-col. 19 line 10, Fig. 7 #710-730];

receiving an indication that at least a portion of the music selection has been recorded in said intermediate storage medium and that a subsequent request to purchase the media selection, said purchase request including a request to store the music selection in a permanent storage medium at said consumer site [see at least: col. 12 lines 12-19, col. 19 lines 18-22, col. 20 lines 45-49 and 56-57, col. 21 lines 41-46, col. 22 lines 56-58, col. 29 lines 4-12, col. 31 lines 24-37];

responsive to said indication, automatically charging the consumer for the music selection [see at least: col. 19 lines 28-43, col. 20 lines 56-57, col. 21 lines 1-4 and 26-35].

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Though teaching all of the above including receiving an indication a subsequent request to purchase the media selection, said purchase request including a request to store the music selection in a permanent storage medium at said consumer site, Wiser only teaches where charging is done prior to the storage of the media in permanent storage media. In other words, Wiser does not expressly teach where the charging *is in response to an indication that at least a portion of the media has been stored in a permanent storage medium at the consumer site* (i.e. charging takes place after the media is permanently stored).

In the same field of endeavor, Hamada teaches a system and method for distribution of media content. More importantly, Hamada teaches where the charging *is in response to an indication that at least a portion of the media has been stored in a permanent storage medium at the consumer site* [see at least: col. 6 lines 36-52, col. 7 lines 55-67, Fig. 14 #s206-208].

It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Wiser to have included the noted features as taught by Hamada because the incorporation of such features is no more than the combination of known prior art elements according to their established function yielding predictable results. Moreover, the invention of Hamada would improve the invention of Wiser by providing a system and method which are more capable of ensuring the protection of data with respect to illicit transfer of specific data [see at least: Hamada, col. 2 lines 17-24].

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Regarding claim 41, the combination further teaches where *the automatically charging is done electronically* [see at least: Wiser, col. 19 lines 28-43, col. 20 lines 56-57, col. 21 lines 1-4 and 26-35].

Regarding claim 48, the combination further teaches *transmitting to the consumer site, for storage on a storage medium at the consumer site, information identifying music selections available for transmission to the intermediate storage medium* [see at least: Wiser, Fig. 8, Fig. 14].

The combination would have been obvious for at least the reasons above.

Regarding claim 49, the combination further teaches *before automatically charging the consumer for the music selection, receiving an indication that the entire music selection has been recorded on the permanent storage medium* [see at least: Hamada, col. 6 lines 36-52, col. 7 lines 55-67].

The combination would have been obvious for at least the reasons above.

Regarding claim 50, Wiser further teaches *communicating an order of said music selection to a central controller, transferring copies of records of said order to a transmission scheduler*, [see at least: col. 13 lines 64-67, col. 18 lines 26-51, Fig. 1 #112 and 118, Fig. 7 #710-730 (Note: content manager/delivery server are analogous to a *central controller* and *transmission scheduler*) and

communicating schedules created by said transmission scheduler to an uplink facility for transmission of said order [see at least: col. 17 lines 29-41, col. 19 lines 18-22, col. 20 lines 56-57, col. 21 lines 41-46, col. 29 lines 4-12, col. 31 lines 24-37]. .

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Hamada teaches the missing steps of *a satellite uplink and transmitting via satellite said order to said customer site* [see at least: col. 4 lines 50-62, Fig. 1, Fig. 14].

The combination would have been obvious for at least the reasons above.

Regarding claim 51, the combination teaches *an action selected from the group consisting of: using a home personal computer for ordering said music selection, using a cell phone for ordering said music selection, using a PDA wireless device for ordering said music selection; ordering said music selection via wireless application protocol* [see at least: Wisner, col. 12 lines 12-19, col. 13 lines 57-63, col. 18 lines 6-19 and 39-51, col. 18 line 63-col. 19 line 10, Fig. 7 #710-730].

Regarding claims 52-53 and 60-63, as well as claims 64-65, 67, and 71, these claims closely parallel claims 40-41 and 48-51 and are thereby rejected for at least similar rationale.

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Claims 43, 55, and 73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiser in view of Hamada as applied above, in further view of PTO form 892 reference U (892u).

Regarding claim 43 and related claims 55 and 73, Wiser in view of Hamada teaches :
informing the consumer that the music selection is available for transmission to an intermediate storage medium of a music sharing system and
providing a mechanism for the consumer to request the music selection while at a website of the music sharing system [see at least: Wiser, col. 12 lines 12-19, col. 17 lines 22-27, Fig. 1 #126, , Fig. 8].

Wiser in view of Hamada, however, does not expressly teach where the music sharing system is *a peer to peer* system .

In the same field of endeavor, 892u teaches the advent of Napster.com – a website/software supporting a virtual community and search engine that makes it a good way to find MP3 files and associated resources. In this regard, 892u teaches where the music sharing system is *a peer to peer* sharing system.

It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Wiser in view of Hamada to have included the noted features as taught by 892u because the incorporation of such features is no more than the combination of known prior art elements according to their established function yielding predictable results. Moreover, 892u would improve the invention of Wiser and Hamada by providing a virtual community for sharing media that combines almost all needed functions such as searching and downloading desired media into a single application [see at least: 892u].

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Claims 44 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiser in view of Hamada in view of PTO form 892 reference U (892u) as applied to claims 43 and 55, and further in view of Wolff (6247047).

Regarding claim 44 and related claim 56, the combination of Wiser, Hamada, and 892u teaches all of the above including *making music available for transmission to the intermediate storage medium* (Wiser) and further where the music sharing system includes *a peer to peer system* (892u). The combination, however, does not expressly teach *paying an operator of said peer to peer music sharing system for advertising*.

In the field of electronic commerce, Wolff teaches the payment of a fee to a sponsor server (*operator*) by a merchant for advertising [see at least: col. 7 lines 21-25].

It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Wiser in view of Hamada in view of 892u to have included the noted features as taught by Wolff because the incorporation of such features is no more than the combination of known prior art elements according to their established function yielding predictable results. Moreover, the invention of Wolff would improve the system and method of Wiser, Hamada, and 892u by providing a banner advertising transaction enabling system on a computer network such as the Internet for use even by merchants with little or no presence on the computer network, thereby creating a system that is inexpensive compared with conventional banner advertising systems [see at least: Wolff, col. 3 lines 31-36].

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Claims 47 and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiser in view of Hamada in view of PTO form 892 reference U (892u) as applied to claims 43 and 55, and further in view of Allen (US 20030036974).

Regarding claim 47 and related claim 59, the combination of Wiser, Hamada, and 892u teaches all of the above including making music available for transmission to the intermediate storage medium (Wiser) and further where the music sharing system includes a peer to peer system (892u). The combination, however, does not expressly teach *creating a profile from customer preference information*.

In the same field of endeavor, Allen teaches a content distribution system including *creating a profile from customer preference information* [see at least: 0013, 0078-0080].

It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Wiser in view of Hamada in view of 892u to have included the noted features as taught by Allen because the incorporation of such features is no more than the combination of known prior art elements according to their established function yielding predictable results. Moreover, the invention of Allen would improve the system and method of Wiser, Hamada, and 892u by promoting to a specific consumer those items which such consumer's previous system activities indicate he or she may be predisposed to purchase (or show additional interest in) [see at least: Allen, 0013].

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Claims 76-78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiser in view of Hamada in view of Doyle (US 5694551).

Regarding claim 76 and related claims 77-78, Wiser teaches all of the above including *transmitting pricing information for the music selection to a customer station located at the customer site* [see at least: col. 11 lines 49-50]. Wiser further teaches where information pertaining to the music selections may be updated [see at least: col. 18 lines 32-36]. Wiser, however, does not expressly teach

periodically transmitting updated pricing information for the music selection to the customer station;

wherein the automatically charging the customer for the music selection is done in accordance with the updated pricing information.

In the same field of endeavor, Doyle teaches *periodically transmitting updated pricing information for the music selection to the customer station;*

wherein the automatically charging the customer for the music selection is done in accordance with the updated pricing information [see at least: col. 4 lines 28-35, col. 5 lines 61-65 (product item update), col. 7 lines 19-24, col. 8 lines 61-67, col. 9 lines 13-21]. Note: the price paid by the customer is the updated price, thus, the customer is charged in accordance with the updated price.

It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Wiser and Hamada to have included the noted features as taught by Doyle because the incorporation of such features is no more than the combination of known prior art elements according to their established function yielding predictable results.

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Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- US 6882979 B1 discloses generating revenue for the use of softgoods that are freely distributed over a network including where it is known to have fully downloaded a softgood, the softgood having a trial version and full version, the full version being unlockable upon payment [see abstract, col. 1 lines 26-40]

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILLIAM ALLEN whose telephone number is (571)272-1443. The examiner can normally be reached on Monday-Friday, 9:00am - 5:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Will Allen
/WILLIAM ALLEN/
Primary Examiner, Art Unit 3625